

Remarks

Reconsideration of the application and allowance of all claims pending are respectfully requested. Claims 1, 2, 6 and 7 are pending.

Claim Rejection – Double Patenting:

Claims 1, 2, 6 and 7 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-14 of copending application 09/815,854. The claims of the '854 application or of this application may change during prosecution such that this provisional rejection is no longer appropriate to maintain. Since this is only a provisional rejection at this time, it is appropriate to defer a further detailed response to this rejection until otherwise allowable subject matter is indicated for this application or the '854 application becomes a patent.

Claim Rejection - 35 U.S.C. §102:

Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. §102 as being anticipated by Snellman, WO98/23108. Applicants discuss herein one or more differences between the applied reference and the claimed invention with reference to one or more parts of the applied reference. This discussion, however, is in no way meant to acquiesce in any characterization that one or more non-discussed parts of the applied reference correspond to the claimed invention.

It is well-settled that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Since the applied reference is missing at least one element of each of applicants' independent claims, applicants respectfully submit that the claimed invention is not anticipated by the applied reference, as further discussed below.

Based on comments in the Office Action, it appears that there may be a misunderstanding with regard to the requirements of a present invention as defined by claim 1. In the "Response to Arguments" section of the Office Action it was indicated, "The applicant argues the prior art

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does not teach a comparison being performed during dialing. The primary examiner disagrees for several reasons:". Claim 1 does not require a comparison of numbers being performed during dialing, and in applicant's preceding reply arguments were not presented relating to a comparison being performed during dialing.

Claim 1 recites the step of comparing a first non-emergency telephone number associated with a current location of the handset in a previously determined non-emergency telephone number. It will be noted that there is no recitation that this comparison be performed during dialing.

Claim 1 further recites that if the first non-emergency telephone number is different than the previous non-emergency telephone number, a message is transmitted containing the first non-emergency telephone number to the wireless handset where the message is a command for the wireless handset to store at its memory the first non-emergency telephone number instead of the previous non-emergency telephone number for access by a user of the wireless handset. It should again be noted that there is no suggestion or requirement that this step is taken during dialing.

As recited in the preamble of claim 1 the subject method is directed to automatically updating a non-emergency telephone number stored in a wireless handset. Based on the requirement for the transmission of a message containing the first non-emergency telephone number to the wireless handset, one of ordinary skill the art would understand that the comparing step and transmitting step of claim 1 is required to be performed in a network element and not by the handset itself. It will also be apparent that the message will have to have been received and stored in the handset prior to the dialing of an emergency number at the handset so that a first non-emergency telephone number (an updated number to dial for emergency assistance) will be utilized instead of the previous stored non-emergency telephone number. In accordance with the requirements of claim 1, the recited updating process has no required correspondence to a time at which the user will initiate a call requesting emergency services. For example, the update process as recited in claim 1 may well be practiced a substantial time prior to the user attempting to initiate a call for emergency services. Therefore, the examiner's arguments related to a comparison being

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performed during dialing is not relevant to a determination of whether claim 1 is anticipated based on the applied reference.

There is no teaching or suggestion in Snellman that a comparison between a current non-emergency telephone number with a previously determined non-emergency telephone number serves as a controlling event determine whether the network will transmit the current non-emergency telephone number to the wireless handset to replace the stored previously determined non-emergency telephone number.

On page 4 of the Office Action, with regard to the teachings alleged to be provided by Snellman of the determining, comparing and transmitting steps of claim 1, several sections of Snellman were identified as allegedly teaching the required limitations. On page 7, the first four paragraphs were said to discuss a user dialing a phone number in it being changed a different phone number depending upon the user's location. Accepting this as true for purposes of argument, this does not satisfy the steps as recited in claim 1. That is, it is the methodology by which an appropriate emergency telephone number is determined and then transmitted to a wireless handset that is important in considering the patentability of claim 1. Thus, such a statement as recited in the Office Action, even if supported by Snellman, does not supply teachings required by claim 1. It was also recited in the Office Action that on page 7, fourth paragraph, the reference states that the phone number can be changed/updated in memory as well. Assuming for purposes of argument that this is true, it still does not provide the required teachings as specified in claim 1.

Page 8, second and fourth paragraphs, were also cited in support of the rejection. In the second paragraph, on page 8, Snellman describes that upon the mobile telephone unit entering a new area/border, predetermined telephone numbers including an emergency number can be transmitted to the mobile telephone. In the fourth paragraph it is merely recited that automatically obtaining a new emergency telephone number is advantageous to the user since the user does not need to take any measures other than by registering in a new area. Based on the description in Snellman, one of ordinary skill in the art would understand that such a transmission of telephone numbers to the mobile unit occurs automatically as part of the initial

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registration process. That is, a newly registering mobile unit would automatically receive a new set of predetermined telephone numbers to be stored at the mobile unit as part of the registration process. However, Snellman provides no teaching or suggestion that a previously stored emergency number in the mobile unit would be utilized in a comparison with another non-emergency telephone number, and that another non-emergency telephone number would be transmitted to the handset only if the another non-emergency telephone number was different from the previous non-emergency telephone number as required by claim 1.

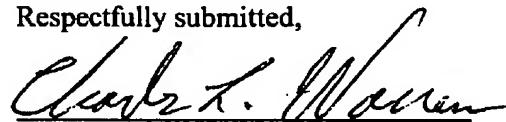
In order for a reference to provide a valid *prima facie* ground to support a rejection under 35 U.S.C. 102, all of the apparatus/steps recited in the subject claim must be taught by the reference. With regard to claim 1, Snellman does not teach all of the required steps as explained above. It should be remembered that claim 1 is a method claim and that all of the steps recited in the method must be taught by Snellman. Even if Snellman were to achieve a comparable end result, this is insufficient where the required steps by claim 1 are not taught as being practiced by Snellman. Therefore, it is requested that the rejection of claim 1 under 35 U.S.C. 102 based on Snellman be withdrawn.

New independent apparatus claim 6 includes apparatus limitations substantially similar to the requirements of claim 1. Thus, claim 6 is believed to be allowable over Snellman for similar reasons explained above with regard to claim 1.

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In view of the above amendments and remarks, allowance of all pending claims is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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Dated: January 8, 2006

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